

PATENT
103095-41585

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:
Rosen et al.

: Art Unit : 1711

Serial No. : 10/661,268

: Examiner : S. Witherspoon

Filed : September 12, 2003

Title : NOVEL MONOFUNCTIONAL
POLYETHYLENE GLYCOL ALDEHYDES:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE AND TERMINAL DISCLAIMERS

Dear Sir:

This paper is being filed in response to my telephone conversation with the Examiner on March 7, 2005.

At the outset, Applicants Attorney wishes to thank the Examiner for the telephone conversation of March 7, 2005. During said telephone conversation the Examiner requested that Terminal Disclaimers be filed in this Application with respect to Serial Number 10/431,294 and Serial Number 10/715,607. The Examiner indicated that with these Terminal Disclaimers, Claims 60-63 will be allowed.

As discussed during this telephone conversation, Claims 60-63 constitute the elected invention in this Application. Therefore, the Examiner is authorized, if he considers Claims 60-63 to be a separate invention, to cancel all other claims in this Application.

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*System
already in
T.D.*

Correspondence and Fees

Please charge Deposit Account Number 03-3839 in the amount of One Hundred Thirty Dollars (\$130.00) for payment of the Terminal Disclaimer Fee under 37 C.F.R. §1.20(d). No additional fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account no. 03-3839 for any underpayment, or to credit any overpayments.

Please address all correspondence to the correspondent address for **Customer No. 26345**. Telephone calls should be made to William H. Epstein at (973) 596-4607 and facsimile communications should be sent directly to him at 973-639-6397.

Respectfully submitted,



William H. Epstein
Attorney for Applicant(s)
Registration No. 20,008

Gibbons, Del Deo, Dolan,
Griffinger & Vecchione, P.C.
One Riverfront Plaza
Newark, New Jersey 07102

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Alexandria, Virginia 22313-1450

**Terminal Disclaimer To Obviate A Double Patenting
Rejection Over A Pending Second Application Serial Number 10/431,294**

Sun Bio, Inc., a corporation having a principal place of business at 57 Claremont Avenue, Orinda, California 94563, the owner of 100% interest in the instant application Serial Number 10/661,268, filed September 12, 2003, as assignee of the entire right, title and interest in and to the said application and in and to any and all Letters Patent of the United States which may issue from said application, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/431,294, filed May 7, 2003, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

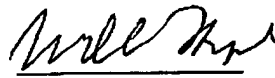
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#821631 v1
103095-41585

the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.
2. ☒ The undersigned is an attorney or agent of record.

 March 7, 2008
Signature Date
William H. Epstein
Registration No. : 20,008

☒ Terminal Disclaimer Fee under 37 CFR 1.20(d) included.

#821631 v1
103095-41585

PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:
Rosen et al.

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: Art Unit : 1711

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: Examiner : S. Witherspoon

Filed : September 12, 2003

Title : NOVEL MONOFUNCTIONAL
POLYETHYLENE GLYCOL ALDEHYDES:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**Terminal Disclaimer To Obviate A Double Patenting
Rejection Over A Pending Second Application Serial Number 10/715,607**

Sun Bio, Inc., a corporation having a principal place of business at 57 Claremont Avenue, Orinda, California 94563, the owner of 100% interest in the instant application, Serial Number 10/661,268, filed September 12, 2003, as assignee of the entire right, title and interest in and to the said application and in and to any and all Letters Patent of the United States which may issue from said application, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/715,607, filed November 18, 2003, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted

#821628 v1
103095-41585

on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer filed prior to its grant.

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1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.
2. ☒ The undersigned is an attorney or agent of record.

William H. Epstein March 7, 2003
Signature Date
William H. Epstein
Registration No. : 20,008

☒ Terminal Disclaimer Fee under 37 CFR 1.20(d) included.

#821628 v1
103095-41585

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE

A PROFESSIONAL CORPORATION
ATTORNEYS AT LAW

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NEWARK, N.J. 07102-5496

OFFICE: (973) 596-4500
TELECOPY: (973) 596-0545

Telecopy Cover Sheet

TELECOPY NUMBER: 1-571-273-0649 CONTACT NUMBER: _____

PLEASE DELIVER THE FOLLOWING PAGES TO:

NAME: Examiner S. Witherspoon

FROM: William H. Epstein, Registration Number 20,008

RE: 103095 - 41585 DATE: March 7, 2005
Client Matter

TOTAL NUMBER OF PAGES TRANSMITTED, INCLUDING THIS SHEET: 19

TRANSMITTED BY: _____ TIME OF TRANSMISSION: _____

MESSAGE:

Serial Number : 10/661,268
Filed : September 12, 2003
Art Unit : 1711
Examiner : S. Witherspoon
Title : Novel Monofunctional Polyethylene Glycol Aldehydes

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Date



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William H. Epstein

Typed or printed name of person signing Certificate

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Registration Number, if applicable

973-596-4607

Telephone Number

Attached please find:

1. Response (2 pgs.)
2. Two (2) Executed Terminal Disclaimers (4 pgs.)

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/681,268	
	Filing Date	September 12, 2003	
	First Named Inventor	Perry Rosen	
	Art Unit	1711	
	Examiner Name	W. Witherspoon	
Total Number of Pages in This Submission	9	Attorney Docket Number	103095-41585

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.62 or 1.63	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Two (2) Executed Terminal Disclaimers; Response.
Remarks		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Gibbons, Del Deo, Dolan, Griffinger & Vecchione	
Signature		
Printed name	William H. Epstein	
Date	March 7, 2003	Reg. No. 20,008

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Signature		
Typed or printed name		Date

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	10/661,268
		Filing Date	September 12, 2003
		First Named Inventor	Perry Rosen
		Examiner Name	W. Witherspoon
		Art Unit	1711
TOTAL AMOUNT OF PAYMENT (\$ 130.00		Attorney Docket No.	103095-41585

METHOD OF PAYMENT (check all that apply)							
<input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (please identify): _____							
<input checked="" type="checkbox"/> Deposit Account Deposit Account Number: 03-3839 Deposit Account Name: Gibbons							
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)							
<input checked="" type="checkbox"/> Charge fee(s) indicated below <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee							
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 <input checked="" type="checkbox"/> Credit any overpayments							
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2638.							
FEE CALCULATION							
1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
2. EXCESS CLAIM FEES							
							Small Entity
Fee Description							Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent							50
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent							200
Multiple dependent claims							360
Total Claims Extra Claims Fee (\$)							Fee Paid (\$)
HP = highest number of total claims paid for, if greater than 20							
Indep. Claims Extra Claims Fee (\$)							Fee Paid (\$)
HP = highest number of independent claims paid for, if greater than 3							
3. APPLICATION SIZE FEE							
If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof				Fee (\$)	Fee Paid (\$)
- 100 = / 50 = (round up to a whole number) x =							
4. OTHER FEE(S)							
Non-English Specification, \$130 fee (no small entity discount)							
Other: (2) Two Terminal Disclaimer Filing Fee							130.00

SUBMITTED BY			
Signature	<i>William H. Epstein</i>	Registration No. (Attorney/Agent)	20,008
Name (Print/Type)	William H. Epstein	Telephone	973-596-4500
		Date	March 7, 2003

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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